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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/389,557 | 09/03/1999 | SHIGEYUKI SANO | 7217/59652 | 5566 |

7590 02/23/2005

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| EXAMINER |
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BRIER, JEFFERY A

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| ART UNIT | PAPER NUMBER |
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2672

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/389,557 | Applicant(s) SANO ET AL. | |
| | Examiner Jeffery A Brier | Art Unit 2672 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/24/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 9/24/2004 has been entered.
2. The amendment to claims 1 and 9 raise new matter issues as will be discussed below.

Response to Arguments

3. Applicant's arguments filed 9/24/2004 have been fully considered but they are not persuasive. The argument on page 5 next to the last paragraph states:

"Features of the control apparatus and method according to the present invention are to control movement of a sub-screen of a variable size containing a compressed sub-screen video signal. See page 5, lines 6-25 of the present application, for example."

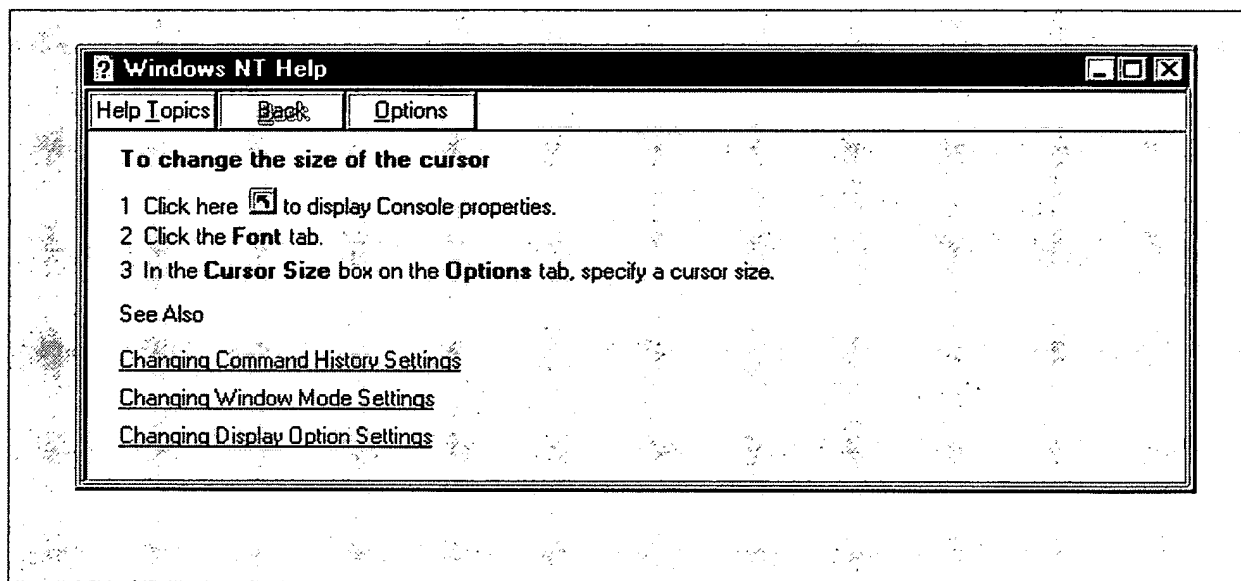
This characterization of the application is incorrect because page 5 lines 11-16 states:

"By this signal and a change of a reading speed at which data is read from an internal memory of the production and control circuit 6, the video signal of the sub screen is compressed to an arbitrary size and derived at an arbitrary timing on the display screen, whereby the video signal of the sub screen is produced." Clearly the specification teaches compressing the video signal to an arbitrary size but it does not teach a sub-screen of an arbitrary size and it does not teach a sub-screen of a variable size.

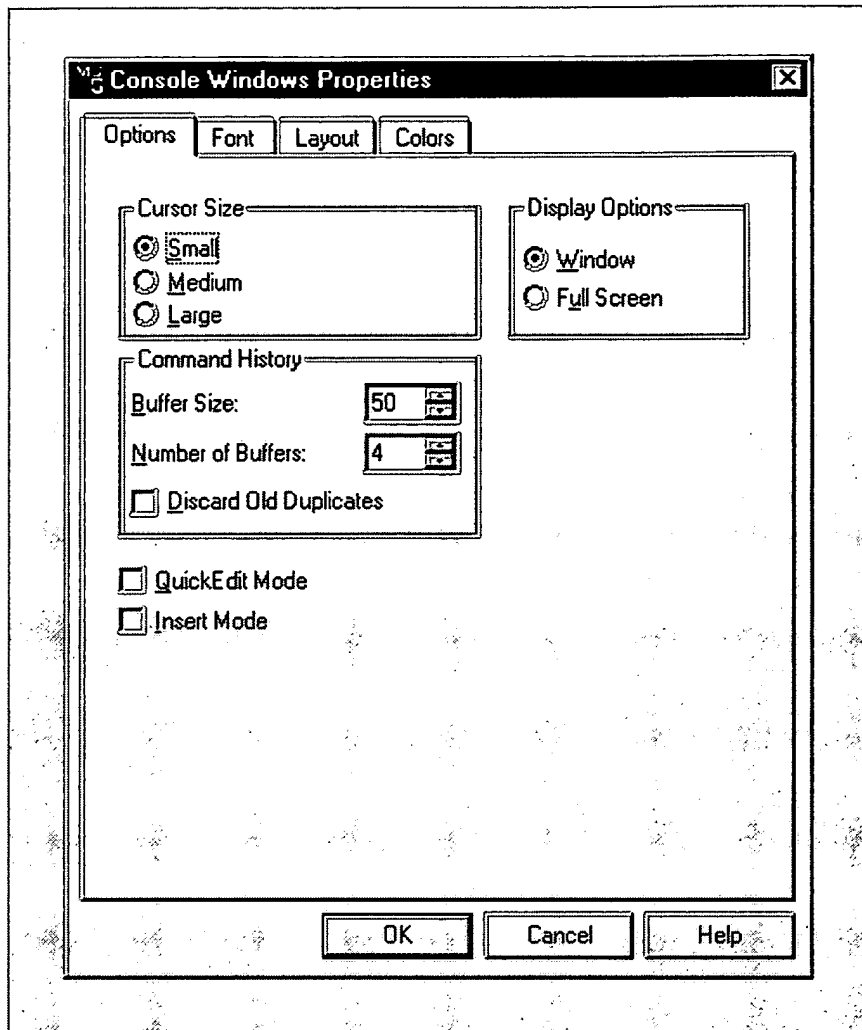
The argument presented on page 6 first paragraph states: "Looking at Sombroek we see that the reference does not teach controlling a movement of a sub-screen of a variable size containing a compressed sub-screen video signal. Sombroek is

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merely teaching controlling a sub-screen containing a cursor.” This statement may be correct, however, the specification does not support claims having the limitation of “a sub-screen of a variable size”. The specification does not define “video signal”, thus, this broad term includes the video signal of a cursor. The cursor generator inherently present in Sombroek places the video signal of the cursor into the sub-screen. It is not clear if the video signal of the cursor is compressed to fit into the size of the sub-screen. However, this is a well known feature of Windows NT. To change the cursor size in Windows NT the following is performed by the user.



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It would have been obvious to one of ordinary skill in the art to have modified Sombroek to include the feature of variable size cursor for many reasons one of which is it will allow a person to view the cursor at the size the user desires to view the cursor. A variable size cursor generator would compress the size of the cursor to fit a selected smaller size cursor.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 9 were both amended to claim "producing said sub-screen of a variable size containing said compressed sub-screen video signal". Page 5 lines 11-16 of the specification states: "By this signal and a change of a reading speed at which data is read from an internal memory of the production and control circuit 6, the video signal of the sub screen is compressed to an arbitrary size and derived at an arbitrary timing on the display screen, whereby the video signal of the sub screen is produced." Clearly the specification teaches compressing the video signal to an arbitrary size but it does not teach a sub-screen of an arbitrary size and it does not teach a sub-screen of a variable size.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 9 were both amended to claim

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“producing said sub-screen of a variable size containing said compressed sub-screen video signal”. The phrase “said sub-screen of a variable size” requires a variable sub-screen be previously claimed, thus, this phrase lacks antecedent basis in the claim.

8. Applicant should note that claim 9 is a method claim that has several occurrences of “means” plus a function. Since claim 9 is a method claim these means plus function phrases do not invoke 112 sixth paragraph since in a method claim a “step for” phrase is necessary to invoke 112 sixth paragraph. Therefore claim 9 may claim less than applicant intends for claim 9 to claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

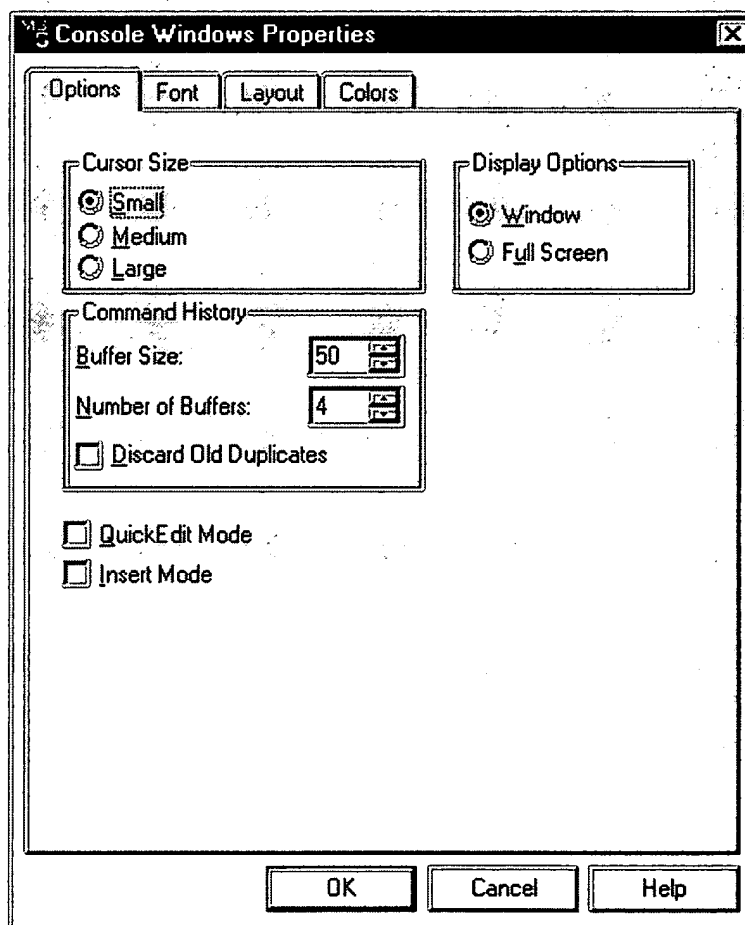
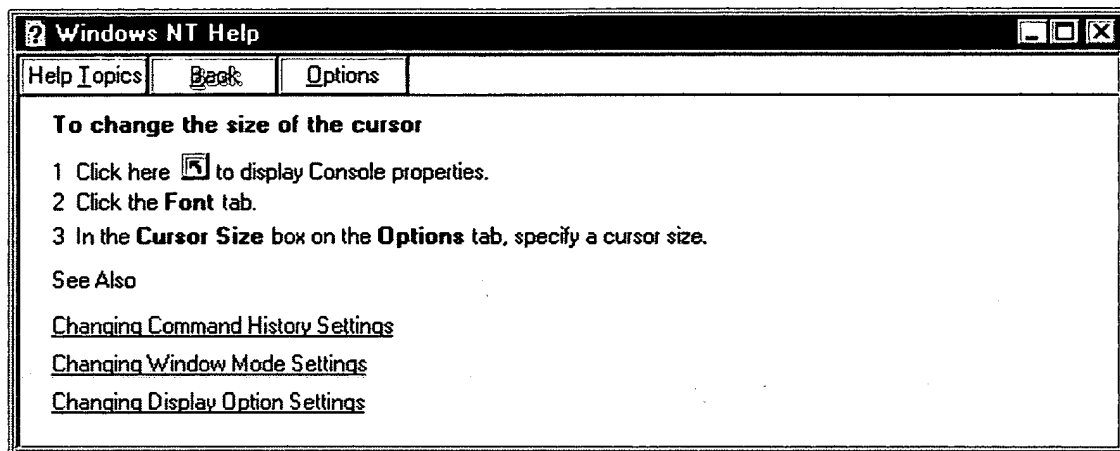
10. In view of the newly added claim limitations into claim 1 “sub-screen signal production control means for compressing a sub-screen video signal and for producing said sub-screen of a variable size containing said compressed sub-screen video signal” and into claim 9 “compressing a sub-screen video signal; producing said sub-screen of a variable size containing said compressed sub-screen video signal;” the following rejection is being made for what the claims currently claim.

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11. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sombroek, EP 0 631 223 A1, in view of Windows NT which was available prior to 1996.

Sombroek at column 5 lines 37-43 describes continuing the shifting of the speed of the cursor. Sombroek describes on column 4 lines 6-9 a joystick used as a user interface tool. At column 4 lines 36-49 Sombroek describes how the cursor is moved at one speed for a first time period and then accelerates to a second speed after the first time period has elapsed. The joystick corresponds to the claimed first and second command means because the joystick supplies at least four signals indicative of left, right, up, and down movement commands. Note figure 4 and pressure sensitive resistors 402-408. Thus, movement of the joystick by the user, indicative of left, right, up, and down, is judged by 304 and 306 as being similar types of input irregardless of direction (column 7 line 45 to column 8 line 7) causing the speed of the cursor to increase as the command means 402-408 in aggregation continuously produces an output within a first time period.

The specification does not define "video signal", thus, this broad term includes the video signal of a cursor. The cursor generator inherently present in Sombroek places the video signal of the cursor into the sub-screen. It is not clear if the video signal of the cursor is compressed to fit into the size of the sub-screen. However, this is a well known feature of Windows NT. To change the cursor size in Windows NT the following is performed by the user.



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It would have been obvious to one of ordinary skill in the art to have modified Sombroek to include the feature of variable size cursor for many reasons one of which is it will allow a person to view the cursor at the size the user desires to view the cursor. A variable size cursor generator would compress the size of the cursor to fit a selected smaller size cursor.

A detailed analysis of the claims follows.

Claim 1:

Sombroek teaches a control apparatus for controlling a displayed position of a sub-screen (*the cursor is displayed in a sub-screen of the main screen*) displayed together with a main screen on a display screen, comprising:

Windows NT teaches sub-screen signal production control means for compressing a sub-screen video signal and for producing said sub-screen of a variable size containing said compressed sub-screen video signal (*When the user changes the size of the cursor, the video signal representing the cursor needs to be changed to fit a variable cursor sub-screen. This is the same as the claimed compressing a sub-screen video signal since applicants use of the word compression is related to changing the size of the image represented by the video signal.*);

Sombroek further teaches the following claim limitations;

first command means (*Both applicant and Sombroek use a joystick.*) to control said position of a sub-screen in a first direction (*The left and right signals of the joystick are generated by a first command means to control the position of the cursor in a first direction.*);

second command means (*Both applicant and Sombroek use a joystick.*) to control said position of a sub-screen in a second direction (*The up and down signals of the joystick are generated by a second command means to control the position of the cursor in a second direction.*); and

processing means for receiving command signals from said first and second command means and for outputting a control signal to control said displayed position of said sub-screen in said first and second directions in response to said command signals (*When the first and second command means is activated for a period less than t_1 the speed of moving the cursor will be maintained at the initial speed, thus, when they are activated intermittently the time period will be less than t_1 , see column 4 lines 36-49 and figure 2*);

wherein said processing means increases at a predetermined moving speed said displayed position of said sub-screen from an initial moving speed when one of said first and second command means is activated continuously (*At column 4 lines 36-49*

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Sombroek describes increasing the speed of moving the cursor after one or both of the first and second command means are activated continuously beyond time period t1. At column 4 lines 36-49 Sombroek describes how the cursor is moved at one speed for a first time period and then accelerates to a second speed after the first time period has elapsed. Movement of the joystick by the user, indicative of left, right, up, and down, is judged by 304 and 306 as being similar types of input irregardless of direction (column 7 line 45 to column 8 line 7) causing the speed of the cursor to increase as the command means 402-408 in aggregation continuously produces an output within a first time period.);

wherein said processing means judges similarity of said command signals when another one of said first and second command means is activated at the state of said predetermined moving speed (*Converter 304 and processor 306 determines if the left, right, up, and down signals from pressure sensitive resistors 402-408 as being similar types of input irregardless of direction (column 7 line 45 to column 8 line 7) since the outputs of pressure sensitive resistors 402-408 are tied together at node 412 column 6 lines 50-51 and their outputs are applied to converter 304. Sombroek's look up table inherently stores values corresponding to the different speed ranges, V1, V2, V3, etc. The calculating means 438 produces a judgment on*

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the similarity of the alternate actions made by the first and second command means based upon the valued stored in the addressed location in the look up table corresponding to the count. Another one is a broad term and is met by the other of up or down and left or right.); and

wherein said processing means continues said predetermined increase of moving speed when said similarity is found (At column 5 lines 41-44 *Sombroek describes increasing the speed from v1 to v2 to v3 to etc. At column 8 lines 2-7 Sombroek describes continuing to increase the speed after similarity has been determined.) and returns to said initial moving speed when said similarity is not found (When the joystick is returned by the user to the center position, the speed of the cursor is returned to zero, column 5 lines 29-35.).*

Claim 9:

This claim is a method version of claim 1 and claims the same functions that claim 1 claims. This claim is rejected for the reasons given for claim 1.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jacquelyn Gavron and Joseph Moran, How to Use Microsoft Windows NT 4 Workstation, 1996, Ziff Davis Press, page 123 teaches customizing Windows NT and provides the 1996 date.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723 until the move and after the move the telephone number will be 571-272-7656. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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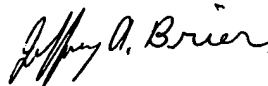
published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Jeffery A. Brier". The signature is written in a cursive style with a large, stylized initial "J".

Jeffery A Brier
Primary Examiner
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